United States Court of Appeals for the Federal Circuit

Catalina Marketing Corporation, Appellant

v. **NOTICE OF APPEAL**

Jon W. Dudas, Appellee.
in his official capacity as
Director of the United States
Patent and Trademark Office,

Catalina Marketing Corporation hereby appeals the court for review of the Decision on Request for Rehearing of the Board of Patent Appeals and Interferences in Appeal No. 2004-1267 in Application No. 08/873,974, entered on September 30, 2004.

Date 11/23/04

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Paper No. 53

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,
DAVID W. BANKER and WILL GARDENSWARTZ

Appeal No. 2004-1267
Application No. 08/873,974

ON BRIEF

Before KRASS, FLEMING and DIXON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request rehearing of our decision of July 29, 2004, wherein we affirmed the examiner's decision rejecting claims 52, 53, 55-59, 62, 72 and 82 under 35 U.S.C. § 103.

Initially, appellants argue that we have not decided an issue involving a rejection under 35 U.S.C. § 112, even though that rejection had been withdrawn by the examiner and was not on

appeal before us. Appellants take the position that the rejection was, in fact, on appeal because they had appealed from the examiner's rejection of the claims under 35 U.S.C. § 112 and that we must decide the propriety of this rejection even in the face of the examiner's withdrawal of such rejection.

We disagree. Once an examiner withdraws a rejection of claims, at or before the time of the answer, that rejection is no longer before us on appeal and we will not issue an opinion as to the propriety of a now-theoretical rejection.

Appellants are concerned that since there was a suggestion of reopening prosecution in our decision[1], a lack of a decision by us regarding the § 112 rejection might leave appellants open to re-imposition of that rejection by the examiner.

If, and when, the examiner deems it appropriate to make a rejection under 35 U.S.C. § 112, and such rejection is appealed to us, we will treat that rejection. But, at least at the time of the answer, the examiner no longer believed a rejection under 35 U.S.C. § 112 to be proper and chose not to make it. The Board would find itself in an awkward position attempting to decide an

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[1]We indicated in the decision, at page 9, that the examiner's rejection of claims 54, 63-69, 73-79, and 83-89 under 35 U.S.C. § 103 was a new ground of rejection, not permitted under 37 CFR 1.193 (a)(2), and remanded to the examiner to either withdraw the rejection or reopen prosecution.

issue on which both appellants and the examiner are in apparent agreement, viz., that a rejection under 35 U.S.C. § 112 was not improper. Where there is no controversy, there is no need for the Board, or any tribunal, to make a decision.

Accordingly, we decline appellants' invitation to render a decision on whether claims are proper, within the meaning of 35 U.S.C. § 112.

Appellants further argue that we misapprehended the claim limitation, "in response to a consumer request..." and the reasoning in support thereof in the brief filed July 10, 2001.

Part of the problem arises from multiple filings, by appellants, of various briefs and supplemental briefs, and attempting to incorporate by reference, into the arguments, all of these briefs. Thus, rather than including all of appellants' arguments in a single brief and/or a brief and possibly one reply brief, the record is rife with arguments scattered throughout several papers.

In any event, our decision did treat the "in response to a consumer request..." limitation of the claims, by indicating, at page 6 of our decision, that any promotion or discount offered in Sloane is clearly "in response to a consumer request." The reason is explained in the paragraph bridging pages 6-7 of the

decision. Thereat, we indicated that the background section of Sloane disclosed that it was known for consumers to request coupons over the internet (see column 2, lines 18-21). Further, we noted, at page 7 of the decision, that even in Sloane's actual invention, a consumer first locates and scans a related product required for a promotion (see column 8, lines 45-49). Accordingly, it is clear that any promotion, or discount, issued is "in response to a consumer request...," as claimed.

Thus, it is clear that, contrary to appellants' assertions, we did not ignore the "in response to a consumer request..." limitation of the claims.

Appellants further argue that we overlooked the brief filed July 10, 2001 and the reasoning therein relative to the inapplicability of the Narasimhan reference. We have reviewed the second supplemental brief, filed July 10, 2001, but find nothing therein to cause us to modify our decision. In that document, appellants simply point out that "there is no evidence supporting the examiner's rationale that transmitting a geographically limited list of retailers honoring incentives in response to a query is a more efficient way of obtaining desired information;" and that the examiner's conclusion of obviousness in combining the teachings of Narasimhan and Sloane "is vague" and "unsupported" by any evidence.

We find appellants' arguments insufficient to overcome the examiner's reasonable explanation that Narasimhan suggests, at column 4, lines 62-65, and column 8, lines 4-13, providing for certain geographic-specific promotions to consumers. Again, appellants do not appear to have addressed the specific teachings of Narasimhan, as pointed out by the examiner. Appellants' mere assertion that there is no evidence supporting the examiner's rationale, or that the examiner's conclusions are "vague," fails to point out the error in the examiner's position that Narasimhan clearly suggests using geographic-specific promotions.

Having responded to each and every assertion made by appellants in the Request for Rehearing, filed August 6, 2004, and finding nothing persuasive therein, we decline to make any modification to our decision of July 29, 2004. Appellants' request for rehearing is granted to the extent that we have reviewed and reconsidered our decision and the evidence of record, but the request is denied with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

ERROL A. KRASS Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)	

EK/RWK

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